

1 invention having a single continuous 'V' belt and multiple cutting means spaced
2 along its length, each with its own power source. Claims 9 - 12 are not
3 applicable to FIG 8 but to FIGs 1 thru 7.

4 Claim 9 is dependent on Claim 1 and teaches that by raising the
5 cutting means (23, 24) so that it does not touch the non-skid continuous
6 conveyor belt means, such as inserting a dado blade to cut a dado into the top
7 face of the product or a router head to shape the top face of the product, then
8 a single non-skid continuous conveyor belt means could be used rather than
9 two.

10 Claim 10 is dependent on Claim 1 and teaches that the apparatus
11 of Claim 1 may be combined end to end to perform multiple cutting or shaping
12 actions on the product in sequence.

13 Claim 11 is dependent on Claim 1 and teaches that the cutting
14 blades (23, 24) can be replaced by high pressure abrasive cutting means, such
15 as high pressure nozzles discharging water jets with sand or oil and sand or
16 diamonds.

17 Claim 12 is dependent on Claim 1 and teaches the cutting blades
18 (23, 24) can be replaced with router cutters or shapers.

19 Applicant requests consideration of Claims 9 thru 12, inclusive.

20 5.ii. Applicant takes exception to the insinuation that applicant did not
21 appropriately set forth two trademarks. The terms, No. 37
22 Scandera Red Carbox Rough Top and Browning Manufacturing
23 Company Grip Notch, are capitalized and accompanied by the
24 generic terminology descriptive of those products.

25 5.iii. Applicant accepts and complies with the objection of the Examiner
26 in the amendments to the Specification set forth below. Applicant
27 request the following changes be made at the specific points indicated:
28 Page 3 line 22 insert the following after "...belt, extending a distance

1 from the bottom surface (29) and having sufficient width to engage a 'V'
2 groove (31) in a feed roller

3 Page 3 line 23 delete [their lengths.] after "...parallel to" and replace
4 with and stretching the entire length of the belts.

5 Page 3 line 24 rewrite the paragraph beginning thereat as follows:

6 The one continuous drive conveyor belt (10) travels around an
7 inside feed roller (42) on the input side [(42)] and a feed roller (8) at the
8 input end [(8)] (50) and the other continuous drive conveyor belt (41)
9 travels around an inside feed roller (43) on the output side [(43)] and a
10 feed roller (34) at the output end [(34)] (51). The distance from the
11 respective inside feed rollers (42, 43) and feed [end] rollers (8, 34) being
12 adjustable at the feed roller mount (9, 16) so as to maintain proper
13 tension on the continuous drive conveyor belt so that it does not slip on
14 the rollers.

15 Page 4 line 6 rewrite the paragraph beginning thereat as follows:

16 With reference to Figures 4, 5, and 6, it is shown said rollers (8,
17 34, 42, 43) are provided with one or more 'V' grooves (31) to accept
18 the guide 'V' belt (30), as is the feed bed (32) provided with one or more
19 'V' grooves (33) to accept the guide 'V' belt (30) bonded to [on] the
20 bottom surface (29) of the continuous drive conveyor belt (10, 41) so
21 that the continuous drive conveyor belt remains in constant horizontal
22 relationship to the feed rollers and the circular saw blades(s) (23, 24) or
23 shaping tool(s) (46). The speed of the input continuous drive conveyor
24 belt (10) is matched with the speed of the output continuous drive
25 conveyor belt (41) by means of a timing belt (15) between the powered
26 shaft (13) of the inside feed roller (43) on the output [end] side [(13)],
27 powered by a feed roller drive motor (21), to the slaved shaft (14) of the
28 inside feed roller (42) on the input [end (14)] side, while the feed roller[s]

1 (8) at the input end [(8)] (50) and the feed roller (34) at the output end
2 [(34)] (51) are turned by the continuous drive conveyor belts. Thus all
3 feed rollers have the same operating revolutions per minute (RPM).

4 Page 5 line 3 rewrite the paragraph beginning thereat as follows:

5 With reference to Figures 1 and 3, it is shown that once a wooden
6 board (44) or other flat, rigid, cuttable piece of material, having a length
7 greater than its width, enters the Feedworks Device (1) on the input
8 continuous drive conveyor belt (10) over the feed roller (8) at the input
9 end [(8)] (50). it is held in a fixed horizontal relationship to the circular
10 saw blade(s) (23, 24) or shaping tool(s) (46) by the non-skid top surface
11 (28) of the input continuous drive conveyor belt (10) and a holddown
12 roller (11) at the input end [(11)] (50) and an inside holddown roller (22)
13 on the input side, said holddown rollers having a non-marring surface and
14 applying pressure to the top of the wooden board (44) by means of a
15 spring or pneumatic cylinder loaded arm (12, 45), while the Feedworks
16 Device (1) has a similar output continuous drive conveyor belt (41) with
17 an inside hold down roller (17) on the output side [(17)] and a hold down
18 roller (19) at the output end [(19)] (51), applying sufficient pressure to the
19 top of the sawn pieces of the wooden board (44) by means of a spring
20 or pneumatic cylinder loaded arm (12, 18, 20, 45), so that the wooden
21 board (44) being cut maintains a constant orientation to the saw blade
22 (23, 24) or shaping means.

23 Applicant requests acceptance of the Amended Fig. 1 submitted herewith
24 showing, in red, an input end (50) and output end (51) for clarification, 37
25 C.F.R. 1.121(3)(ii). A substitute sheet of drawing Fig. 1 is also included, 37
26 C.F.R. 1.121(3)(i).

27 6. Applicant submits herewith a reaccomplished Claims Section of the
28 application commencing on a separate sheet in compliance with 37 C.F.R.

1 1.52(b).

- 2 i. Claim 1 is amended to satisfy the Examiners objections;
3 Claim 2 is amended to satisfy the Examiner's objections (Note:
4 applicant refers Examiner to page 4 line 20 of the original
5 specification for the antecedent basis for "the length"). The
6 amendments to the specification and drawing should satisfy the
7 remaining objections;
8 Claim 3, Examiner is referred to page 4 line 20 of the unamended
9 specification for the antecedent basis for "the length";
10 Claim 4 objections of the Examiner should be satisfied by the
11 amendments to the specification.
12 ii. Examiner's objections should be satisfied by the amendments to the
13 specification.
14 iii. Examiner's objections to Claims 3 and 6 should be satisfied by the
15 amended Claims.
16 iv. Claim 3 Examiner objections should be satisfied by the amendments
17 to the Claims. the 'V' groove refers to the sections of reduced
18 diameter of the inside feed rollers, while the "Guide means" is the
19 'V' belt bonded to the bottom surface of the non-skid continuous
20 conveyor belt.
21 v. Objections of Examiner to Claim 4 should be satisfied by the
22 amendments. The two non-skid continuous conveyor belt
23 assemblies are identical except the motor directly drives the inside
24 feed roller on the output side.
25 vi. the products included in Claim 7 are not known by the applicant to
26 be trademarked but the product manufacturer is named as well as
27 its description for the products. There is no intent to claim a
28 Trademark and applicant's Claim is to a new, novel and non-

obvious combination.

vii. The Examiner's objections should be satisfied by the amended Claim and preference is made to page 5 line 13 of the unamended specification for antecedent basis for alternatively using a spring or a pneumatic cylinder to preload the holddown rollers.

Applicant requests re-examination of the Claims, including Claims 9 thru 12, in light of the foregoing and the amendments submitted herewith.

Pursuant to 37 C.F.R. 1.121(a)(2)(ii), applicant requests the attached Amended Claims be substituted for the like numbered pending Claims and new Claim 14 be allowed.

LEGAL AUTHORITIES

Examiner Goodman rejects Claims 1, 3, 4, 5, & 7 as being anticipated by Hoffa, U. S. Patent Number 5456148, Oct. 1995. Perhaps the original application did not clearly emphasize the unique features of applicant's invention over the prior art. Applicant's new combination of existing elements in a new field, the wood products industry, solves the problem of elimination of the wobbling of the face being cut or milled of wood boards of irregular thickness by a simple machine with a minimum of mechanical parts and able to be manufactured for a substantially reduced cost over complex existing apparatus in the wood products industry. Applicant asserts that the Hoffa patent, being in the field of metal wire horizontal cutting and stripping, does not anticipate applicant's apparatus. (See Declarations filed herewith.)

"35 U.S.C. 102(b). The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

Applicant refers specifically to his Declaration filed herewith to the detailed differences between his improved device and Hoffa's Patent.

1 M.P.E.P. 706.02(a), at page 700-10): "...In other words, for anticipation
2 under 35 U.S.C. 102, the reference must teach every aspect of the
3 claimed invention either explicitly or impliedly. Any feature not directly
4 taught must be inherently present."

5 If the identical invention is not shown in complete detail there is no
6 anticipation (Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 2
7 U.S.P.Q. 2d 1051 (Fed Cir 1987); Richardson v. Suzuki Motor Co. 868 F.2d
8 1226, 9 U.S.P.Q.2d 1913 (Fed Cir 1989)). The detailed differences are
9 identified and explained by applicant in his Declaration. The limitation on
10 impliedly teaching the aspects of the invention is found in the requirement of
11 the examiner to prove by extrinsic evidence that the field of the invention
12 inherently possesses the knowledge sought to be implied. In this case,
13 Examiner Goodman cites no extrinsic evidence in support of his conclusions
14 (Continental Can v. Monsanto, Co, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed
15 Cir 1991)). It isn't knowledge of the Examiner after completing whatever
16 search he desires. It is the knowledge of the industry.

17 Even without the detailed differences, the Hoffa Patent is not within the
18 field of wood cutting and shaping machines so it does not anticipate the
19 Applicant's improved apparatus. Even the U. S. Patent Office does not put the
20 Hoffa Patent in the same subclass as the wood cutting machines. None of the
21 U. S. Patents cited by the Examiner in this case cite Hoffa's U. S. Patent as
22 prior art. Hoffa is not material.

23 It is important to note that Owens' invention is a new improved
24 combination of existing elements in a new field to produce a new function, i.e.
25 moving irregular thickness wood boards through a cutter at a constant speed
26 without the wood wobbling against the cutter. This invention is not anticipated
27 by prior art (Beatty Safway Scaffold Co. v. Up-right Inc., C.A. Or. 1962, 306
28 F.2d 626, cert. den. 83 S.Ct. 881, 372 U.S. 934, 9 L.Ed.2d 766). None of the

1 numerous citations of the applicant and the Examiner show the solution to the
2 problem presented and solved by applicant (Handy v. American Flyer Mfg. Co.,
3 D.C.N.Y. 1930, 44 F.2d 633, aff'd 48 F.2d 1074). Finally, the commercial
4 success of the applicant's invention is an important factor in determining
5 patentability (United Chromium Inc. v. International Silver Co., D.C.Conn 1931,
6 53 F.2d 390, Modified on other grounds 60 F.2d 913, cert.den. 53 S.Ct. 319,
7 288 U.S. 600, 77 L.Ed. 976).

8 Examiner Goodman rejects Claims 1 - 6 and 8 under 35 U.S.C. 103(a) as
9 being unpatentable over Zimmerman in view of Chambers and Baranski.

10 35 U.S.C. 103(a): "A patent may not be obtained though the invention
11 is not identically disclosed or described as set forth in section 102 of this
12 Title, if the differences between the subject matter sought to be patented
13 and the prior art are such that the subject matter as a whole would have
14 been obvious at the time the invention was made to a person having
15 ordinary skill in the art to which said subject matter pertains."

16 M.P.E.P. 706.02(a): "...Whereas, in a rejection based on 35 U.S.C. 103,
17 the reference teachings must somehow be modified in order to meet the
18 claims. The modification must be one which would have been obvious
19 to one of ordinary skill in the art at the time the invention was made. See
20 M.P.E.P. 2131 - 2146 for guidance..."

21 M.P.E.P. 706.02(j): "...[T]o establish a prima facie case of obviousness,
22 three basic criteria must be met. First, there must be some suggestion or
23 motivation, either in the references themselves or in the knowledge
24 generally available to one of ordinary skill in the art, to modify the
25 reference or to combine reference teachings. Second, there must be a
26 reasonable expectation of success. Finally, the prior art reference (or
27 references) must teach or suggest all the claims limitations. The teaching
28 or suggestion to make the claimed combination and the reasonable

1 expectation of success must both be found in the prior art and not based
2 on applicant's disclosure. In Re Baeck, 947 F.2d 488, 20 U.S.P.Q.2d
3 1438 (Fed. Cir. 1991)."

4 There are two important principles which may have been overlooked by
5 Examiner Goodman. First, looking at the prior art after having read the
6 applicant's disclosure acts like a retro-spectro-scope and distorts the prior art.
7 When the out-come is known the pieces of the puzzle of the prior art are more
8 easily assembled. Second, it is not the knowledge of the Examiner but the
9 knowledge held and available to persons of ordinary skill in the art to which the
10 subject matter applies...wood products machinery designers and manufacturers.
11 Hindsight of the examiner afforded by the invention cannot be used to negate
12 its insight (Becton Dickinson and Co. v. C.R. Bard Inc., D.N.J. 1989, 719
13 F.Supp 1228, 12 U.S.P.Q.2d 1678, aff'd 922 F.2d 792, 17 U.S.P.Q.2d 1097).

14 The immateriality of the Hoffa Patent to the 102(b) analysis, likewise
15 applies to the 103(a) analysis. People of ordinary skill in the limber industry
16 would not have looked to the wire fencing industry for solutions (Wang
17 Laboratories Inc. v. Toshiba Corp., C.A.Fed (Va.) 1993, 993 F.2d 858, 26
18 U.S.P.Q.2d 1767, reh.den., in banc suggestion declined; See also In Re Oetiker,
19 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992)).

20 The synergistic effect of applicant's invention solves a problem that had
21 long plagued the wood products industry, i.e. how to eliminate wobble from the
22 wood face being cut (TWM Mfg. Co. Inc. v. Dura Corp., C.A. 6 (Mich.) 1983,
23 722 F.2d 1261, 221 U.S.P.Q. 25, on remand 231 U.S.P.Q. 525). The
24 commercial success, the longfelt but unresolved need and the differences
25 between the prior art and the subject invention (See applicant's Declaration)
26 weigh against a finding of "obviousness" under 103(a) (California Medical
27 Products, Inc. v. Tecnol Medical Products, Inc., D.Del. 1995, 921 F.Supp.
28 1219).

1 It is not enough that prior art had identified various elements of
2 applicant's invention because the elements had never been combined in the
3 claimed configuration, the combination was not obvious to persons of ordinary
4 skill in the wood products industry, the present invention is significantly
5 different than the prior art and it is a commercial success (Lee's Aquarium & Pet
6 Products Inc. v. Python Pet Products Inc., S.D.Cal. 1997, 951 F. Supp. 1469,
7 Aff'd 152 F.2d 945).

8 Perhaps the clearest elimination of "obviousness" as a bar to applicant's
9 invention is the failure of the prior art to suggest the desirability of the
10 combination. There is nothing in the disclosures of the prior U.S. Patents cited
11 by the Examiner to suggest combining their teachings and the Examiner cites
12 to no authority for there to be such knowledge or suggestion available to those
13 of ordinary skill in the wood products industry (In Re Jones, C.A. Fed 1992,
14 958 F.2d 347, 21 U.S.P.Q.2d 1941; See also Uniroyal Inc. v. Rudkin-Wiley
15 CORP, C.A. Fed (Conn) 1988, 837 F.2d 1044, 5 U.S.P.Q.2d 1434, cert.den
16 109 S.Ct 75, 488 U.S. 825, 102 L.Ed.2d 51). It is not whether prior art
17 "could" have been modified to product the claimed invention, but whether the
18 prior art "suggested" the desirability of the modification. (In Re Fritch, C.A.Fed
19 1992, 972 F.2d 1260, 23 U.S.P.Q.2d 1780).

20 Finally, the superiority of the claimed invention in performance over the
21 prior art and its advantages of simplicity in mechanical function, reduced cost
22 of manufacture and reduced maintenance costs over the prior art must be
23 considered in determining obviousness (Henkel Corp. v. Coral Inc., N.D.Ill 1990,
24 754 F.Supp 1280, 21 U.S.P.Q.2d 1081, aff'd 945 F.2d 416). The Examiner
25 is respectfully requested to reconsider his rejections on anticipation and
26 obviousness in light of the amendments to the specification and Claims
27 submitted herewith and the Declarations.

28 SEE NEXT PAGE FOR CORRECTED CLAIMS